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In re Application of
ESCH, Uwe *et al*
U.S. Application No.: 09/331,705
PCT No.: PCT/EP97/05792
Int. Filing Date: 21 October 1997
Priority Date: 19 December 1996
Docket No.: 2698/MEINKE (053735-87549)
For: HYDRAULIC CIRCUIT FOR A
HYDRAULIC EXCAVATOR

**DECISION ON RENEWED
PETITION FOR REVIVAL
UNDER 37 CFR 1.137(b)**

This decision is in response to applicants' "Petition to Revive Unintentionally Abandoned Application Under 37 C.F.R. §1.137(b)" ("Pet.") filed on 29 June 2004.

BACKGROUND

On 21 February 2001, a decision dismissing applicants' petition to revive under 37 CFR 1.137(b) and petition to withdraw the holding of abandonment was mailed. Applicants failed to provide a complete declaration as required to satisfy 37 CFR 1.137(b)(1). Applicants were given two months to respond with extensions of time available.

On 29 June 2004, applicants filed the instant petition which was accompanied by, *inter alia*, a "Response to Notification of Missing Requirements Under 35 U.S.C. 371," a "Change of Correspondence Information," a "Sub-Power of Attorney," and a copy of page 3 of a German language declaration.

DISCUSSION

Delay in Responding to the Decision Mailed 21 February 2001

The decision mailed 21 February 2001 provided two-months to respond with extensions of time available pursuant to 37 CFR 1.136(a). However, applicants failed to respond until filing the instant petition on 29 June 2004.

Section 711.03(c) of the MPEP, section H. *Request For Reconsideration*, discusses this situation and states, in part:

Where an applicant files a renewed petition, request for reconsideration, or other petition seeking review of a prior decision on a petition pursuant to 37 CFR 1.137 outside the time period specified in 37 CFR 1.137(e),

the Office may require, inter alia, a specific showing as to how the entire delay was "unavoidable" (37 CFR 1.137(a)) or "unintentional" (37 CFR 1.137(b)).

In the renewed petition, applicants claim that the former attorney had left the employment of the law firm and that the above-referenced "file did not include a copy of the decision on the petition. The applicant's current attorneys contacted the PCT branch of the USPTO and obtained a copy of the decision on the petition filed November 9, 2000. The decision was faxed to applicant's current attorneys on June 17, 2004." Pet. at ¶ 2. Applicants also declare that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR §1.137(b) was unintentional."

The explanation and statement are sufficient to show that the delay in responding to the decision mailed 21 February 2001 was unintentional.

Change of Correspondence Address

Applicants submitted a "Change of Correspondence Information" with the instant petition. All correspondence will now be mailed to:

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575 Madison Avenue
New York, New York 10022-2528

Renewed Petition to Revive Under 37 CFR 1.137(b)

Applicants included a document titled "Response to Notification of Missing Requirements Under 35 U.S.C. 371," with the instant petition claiming that the Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) and Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) mailed 28 July 1999 "were issued in error as the declaration filed with the application noted the citizenship of each inventor as being from Germany." Applicants included a copy of page 3 of the originally filed German language declaration which shows the citizenship of both inventors, Uwe Esch and Gotfried Drieschner, under a box titled Staatsangehörigkeit.

A review of the above-captioned application file shows that the bottom of page 3 of the declaration filed 18 June 1999 submitted to the USPTO via facsimile does not contain the citizenship information for the second inventor. It may have been cut off by the facsimile machine.

Regardless, applicants are responsible with submitting a complete declaration in

compliance with 37 CFR 1.497(a) and (b) to the USPTO. The declaration filed on 18 June 1999 was not in compliance since the citizenship information was missing. Therefore, the Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) and Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) mailed 28 July 1999 were not issued in error. Applicants' subsequent failure to provide an adequate and/or timely response led to the abandonment of this application.

In the response filed 29 June 2004, applicants still have not provided a declaration in compliance with 37 CFR 1.497(a) and (b). The third page of a declaration submitted with the instant petition is the same page of the declaration submitted on 09 November 2000. As indicated in the 21 February 2001 decision, applicants must provide a complete declaration to satisfy the requirements of 37 CFR 1.137(b)(1). A partial declaration is not sufficient.

CONCLUSION

Since a proper reply has not yet been received, applicants' petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The above-captioned application remains **ABANDONED**.

If reconsideration on the merits of either petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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